

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

(Attorney Docket No. 14969US01)

In the Application of:

Geoffrey Flagstad

**Filed Electronically on:
November 28, 2011**

Serial No.: 10/679,749

Filed: October 6, 2003

For: MEDICAL RECORD CARDS AND
STORAGE SYSTEMS

Examiner: Rachel L. Porter

Group Art Unit: 3626

Confirmation No.: 2813

**STATEMENT OF THE SUBSTANCE OF
AUGUST 26, 2011, OFFICE INTERVIEW**

Mail Stop: Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria VA 22313-1450

Sir:

As the Examiner requested in the paper mailed October 27, 2011, the Remarks section of this paper provides a statement of the substance of the August 26, 2011, Office interview between the undersigned attorney and the Examiner.

The formal drawings requested in the October 27, 2011, paper also accompany this paper.

Remarks

This paper responds to the October 27, 2011, paper mailed from the U.S. Patent and Trademark Office respecting the August 26, 2011, Office interview between the undersigned attorney and the Examiner.

As requested by the Office, formal drawings are being filed with this paper.

This paper:

- is responsive to the completed PTOL-413, "Applicant-Initiated Interview Summary," sent from the USPTO on September 9, 2011,
- addresses the seven numbered points required for "recordation of the substance of any interview" recited in the instructions of that document, and
- also answers questions raised by the Examiner in the interview.

The seven numbered points are addressed in corresponding numbered sections below:

- (1) No exhibit was shown and no demonstration was conducted.
- (2) Claim 1 was discussed.
- (3) The Segal prior art identified in the Examiner's "Applicant-Initiated Interview Summary" was discussed. Joao U.S. Pat. No. 6283761 was also discussed.
- (4) The amendments made in "Amendment G" filed August 29, 2011, were discussed.
- (5) In addition to the points identified in the "Applicant-Initiated Interview Summary," the Applicant mentioned the following points, in some cases supplemented here:
 - a. Regarding the 35 U.S.C. 101 issue, the Applicant's main argument is on pages 17-18 of Amendment F filed on July 29, 2011, addressing Part B of the Bilski Factors.

- b. The Examiner requested a specification reference defining the term "covered entity" used in the claims. The Examiner may refer to Paragraph 0006 of the specification, indicating that "covered entity" is a term defined by HIPAA (the Health Insurance Portability and Accountability Act of 1996) and its associated regulations. The Examiner may refer to Paragraph 0034-0035 of the specification, providing a definition of a "covered entity." That definition is further discussed below after this summary of the seven numbered points.
 - c. The undersigned discussed during the interview that the Segal and Joao references are understood by the undersigned to disclose storage of any medical information provided by the patient in the medical records of a "covered entity." Consequently, this information cannot be further transmitted by any entity other than the patient without HIPAA restrictions, so the present claimed methods are not being carried out and the presently defined system is not provided. This position is further discussed below after this summary of the seven numbered points.
- (6) No other pertinent matters were discussed, excepting those described in the Examiner's "Applicant-Initiated Interview Summary,"
- (7) The outcome of the interview is correctly described in the Examiner's "Applicant-Initiated Interview Summary,"

FURTHER REMARKS

What is a "Covered Entity?"

Expanding the point made in part (5)b above regarding the definition of the term "covered entity" used in the claims, the specification defines a "covered

entity" as follows. Referring to Paragraph 0034, but changing the order, a covered entity is one of three types of entities:

- a "health care provider,"
- a "health plan," or
- (most relevant here) a "health care clearinghouse,"

"who transmits any health information in electronic form in connection with a transaction." In other words, to be a covered entity, the entity must meet one of the three bullet points and must transmit health information in electronic form.

In the context of the present invention, the claimed "service provider" might need to be able to transmit health information in electronic form. Thus, to satisfy claim 1 which requires that the service provider is not a "covered entity," the service provider cannot be a "health care provider," cannot be a "health plan," and (most relevant here) cannot be a "health care clearinghouse." Those three types of entities are further explained below and in paragraph 0034.

A "health care provider" is a "provider of medical or health services," including any "person or organization [that] furnishes, bills or is paid for health care in the normal course of business." In other words, a health care provider is a physician, a dentist, a hospital, and so forth. The service provider cannot be a health care provider and meet claim 1; health care providers are covered entities.

A health plan is "an individual or group plan that provides, or pays the cost of, medical care." This is a health insurance company. The service provider cannot be a health insurance company and meet claim 1; health plans are covered entities.

A health care clearinghouse ("HCC") is formally defined, as in Paragraph 0034, as a "public or private entity" that either "[p]rocesses or facilitates the processing of health information received from another entity in a nonstandard format or containing nonstandard data content into standard data elements or a

standard transaction" or "[r]eceives a standard transaction from another entity and processes or facilitates the processing of health information into nonstandard format or nonstandard data content for the receiving entity." This is a long definition, but the essence is that the health care clearinghouse is an entity that data processes health information. The service provider cannot be a health care clearinghouse and meet claim 1. This means that the service provider cannot data process health information and still meet the requirements of claim 1.

Segal and Joao are Readily Distinguished

Expanding on point (5)c above, one clear distinction between either Segal or Joao as relied on by the Examiner, and the present invention of claim 1, is the requirement of claim 1 for: "the service provider that is not the patient or a covered entity storing said converted medical record in a memory that is not a medical record received from a covered entity."

Take Joao FIG. 1 for example, which follows.

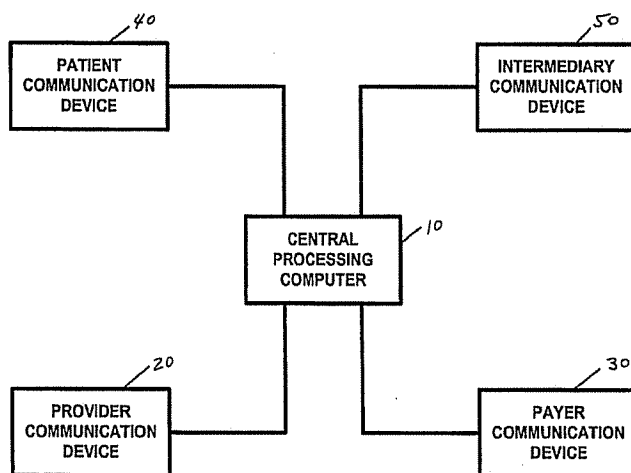
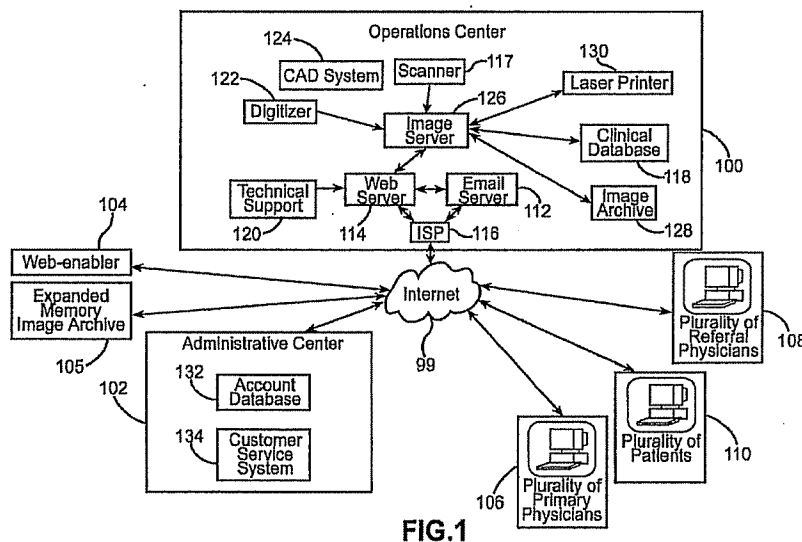


FIG. 1

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This Figure shows access of four parties to a single medical record in the central processing computer 10. Those four parties are a health care provider represented by 20 (like a physician), a "health plan" represented by 30 (both covered entities), the patient, represented by 40, and an "intermediary" represented by 50. Any modifications made by the patient or any other party are being stored in the medical record of a covered entity (in 10). This does not satisfy the requirement in Claim 1, part D, of "the service provider that is not the patient or a covered entity storing said converted medical record in a memory that is *not* a medical record received from a covered entity." The memory 10 is "a medical record received from a covered entity."

Respecting Segal, see FIG. 1 on the next page:



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Again, all parties, including physicians represented by 106 and 108 and patients represented by 110 are storing information, including any records modified by the patient, in the medical record of a covered entity (a clinical database 118, within box 100). This does not satisfy the requirement in Claim 1, part D, of "the service

provider that is not the patient or a covered entity storing said converted medical record in a memory that is *not* a medical record received from a covered entity."
The memory 118 is "a medical record received from a covered entity."

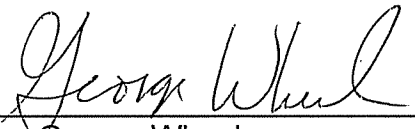
Conclusion

The Examiner is respectfully requested to reconsider and withdraw the rejections and objections of record and to allow claims 1, 5-30, and 32-64 in view of the amendments and remarks made in the response filed July 29, 2011, the Office interview of August 26, 2011, the supplemental response filed August 29, 2011, and the present paper.

The Commissioner is hereby authorized to charge any additional fees presently required or credit any overpayment to Deposit Account No. 13-0017.

Respectfully submitted,

Dated: November 28, 2011

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